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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,710	12/28/2001	Toshiyuki Sato	TAIYO.YAMAGATA.PTI	2502
24943	7590	03/08/2005	EXAMINER	
INTELLECTUAL PROPERTY LAW GROUP LLP			PUNNOOSE, ROY M	
12 SOUTH FIRST STREET			ART UNIT	PAPER NUMBER
SUITE 1205				
SAN JOSE, CA 95113			2877	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/040,710	SATO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Roy M. Punnoose	2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 October 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-30 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15 are drawn to a grain quality judging sample container, classified in class 356, subclass 244.
  - II. Claims 16-25 are drawn to an image reading device, classified in class 382, subclass 110.
  - III. Claims 26-30 are drawn to a sample-arraying jig, classified in class 356, subclass 244.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group II has separate utility such as scanning documents for obtaining images of said documents. See MPEP § 806.05(d).
3. Inventions III and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group III has separate utility such as sample sorter for sorting objects of a desired sizes or shapes. See MPEP § 806.05(d).
4. Inventions III and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group III has separate utility such as sample sorter for sorting objects of a desired sizes or shapes. See MPEP § 806.05(d).

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5. Because inventions of Groups I, II and III are distinct for the reasons given above and/or have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of the claimed invention:

A. Invention of Group I contains the following patentably distinct species:

- i. Species I - Figure 2 (which may read on claims 1, 4, 7, 10 and 13).
- ii. Species II- Figure 4A & 4B (which may read on claims 2, 5, 8, 11 and 14).
- iii. Species III- Figures 11A & 11B (which may read on claims 3, 6, 9, 12 and 15).

7. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 appears to be generic.

B. Invention of Group III contains the following patentably distinct species:

- i. Species I - Figure 25 (which may read on claims 26-28).
- ii. Species II – Figure 23 (which may read on claim 29-30).

8. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 29 appears to be generic.

9. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### **EXAMINER'E COMMENTS**

##### ***Specification***

11. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The Examiner has noted the following errors as listed below:

- a. Reference number 40 (see page 34 first paragraph) is missing in Figures 8A and 8B.

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- b. Reference number 40A (see page 34, 2nd paragraph) is missing in Figures 8A and 8B.
- c. In claim 26, 2nd paragraph, line 4, "as" between "interval" and "has" instead of "and".

There may be more errors in the application, and therefore the applicant is requested to thoroughly examine the application and make appropriate corrections.

*Claim Objections*

12. Claims 4, 7, 10 and 13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous and/or parent claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the instant case, claims 4, 7, 10 and 13 are directed to a quality judger and do not further limit the structure of the sample container of claim 1. Accordingly, said claims do not have any patentable weight.

13. Claims 5, 8, 11 and 14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous and/or parent claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the instant case, claims 5, 8, 11 and 14 are directed to a quality judger and do not further limit the structure of the sample container of claim 2. Accordingly, said claims do not have any patentable weight.

14. Claims 6, 9, 12 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous and/or parent claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the instant case, claims 5, 8, 11

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and 14 are directed to a quality judger and do not further limit the structure of the sample container of claim 3. Accordingly, said claims do not have any patentable weight.

15. Claims 20-23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous and/or parent claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the instant case, claims 20-23 are directed to a quality judging device and do not further limit the structure of the grain image reader of claim 16. Accordingly, said claims do not have any patentable weight.

16. Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous and/or parent claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the instant case, claim 28 is directed to a sample arraying method and do not further limit the structure of the sample arraying jig of claims 26 or 27. Accordingly, said claim do not have any patentable weight.

17. In summary, it should be noted that if a parent/independent claim is directed to a device/apparatus, its dependent claim(s) should further limit the structure of the device/apparatus of the claim it depends on. Similarly, if a parent/independent claim is directed to a method, its dependent claim(s) should further limit the method-steps of the method-claim it depends on.

***Priority***

18. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 06 July 2000. It is noted, however, that applicant has not filed a certified copy of the Japanese application (2000-205743) as required by 35 U.S.C. 119(b).

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***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Roy M. Punnoose** whose telephone number is **571-272-2427**.

The examiner can normally be reached on 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gregory J. Toatley, Jr.** can be reached on **571-272-2059**. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Roy M. Punnoose**  
Patent Examiner  
Art Unit 2877  
February 27, 2005



**Gregory J. Toatley, Jr.**  
Supervisory Patent Examiner  
*3/1/05*

